REMARKS

Claims 17-21 stand rejected under 35 U.S.C. § 101 as being directed to a computer data signal embodied in a carrier wave.

Claims 1, 4, 7, 10, 12 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Okada (U.S. Patent No. 6,148,140) (hereinafter "Okada").

Claims 2, 3, 5, 8, 9, 11, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada in view of Nozaki (U.S. Patent No. 6,501,727) (hereinafter "Nozaki").

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Kikuchi (U.S. Patent No. 6,553,180) (hereinafter "Kikuchi").

Rejections under 35 U.S.C. § 101

Claims 17-21 stand rejected under 35 U.S.C. § 101 as being directed to a computer data signal embodied in a carrier wave. Applicants respectfully traverse this rejection for at least the following reasons. The "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" as recently published in the Official Gazette dated November 22, 2005 sets forth a detailed discussion in section (c) of Annex 4, directed to "Electro-Magnetic Signals" and how such claims are often non-statutory, as asserted by the Examiner in the Office Action.

However, in the second to the last paragraph of this section of Annex 4, the USPTO goes on to direct that "from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In

other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal."

Applicants respectfully submit that the combinations of claims 17-21 of the instant application are directed to such a data signal encoded with functional descriptive material. It is evident that the Examiner understands this because claimed combinations including similar features in the co-pending information recording medium claims have rightfully not been rejected under 35 U.S.C. § 101. Accordingly, for at least these reasons, Applicants respectfully request that the rejections under 35 U.S.C. § 101 be withdrawn.

Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1, 4, 7, 10, 12 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Okada. Claims 2, 3, 5, 8, 9, 11, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada in view of Nozaki. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Kikuchi. These rejections are respectfully traversed as being based upon references that do not teach, or even suggest, all of the features of the combinations described in each of independent claims 1, 7 and 12 of the instant application for at least the following reasons.

Applicants respectfully submit that the Office Action interprets the tentative control information described in each of the instant application's independent claims as information for VOB#1-VOB#3 recorded in an RTRW management file, as described in FIG. 4A of Okada. However, Applicants respectfully submit that such an interpretation is technically incorrect for at least the following reasons.

Applicants respectfully submit that the information for VOB#1-VOB#3 recorded in an RTRW (Real Time Rewritable, see col. 14, line 16) management file disclosed by Okada is information showing attributes for each VOB stored in an AV file. See col. 26, lines 3-4 of Okada. FIG. 12A of Okada shows the detailed hierarchical structure in which data is stored in the RTRW management file. The information for VOB#1-VOB#3 recorded in the RTRW is provided with: VOB General Information; Stream Attribute Information; Time Map Table; and Seamless Linking Information. See FIG. 12A, and col. 26, line 1 to col. 27, line 38 of Okada. Therefore, Applicants respectfully submit that after editing VOB#1-VOB#3, the information in the RTRW can be changed. In other words, the information in the RTRW is information which is changed as data of VOB#1-VOB#3 is edited, added, or changed, but not information for forming something. If data of VOB#1-VOB#3 is not changed, the information in the RTRW is not changed.

On the other hand, Applicants respectfully submit that the tentative control information described in each of the independent claims of the instant application is information used for forming managing control information later on to record it in a recordable recording medium. The managing control information is changed when data is changed. Therefore, Applicants respectfully submit that that the managing control information could be understood as being similar to the information in the RTRW of Okada. However, the tentative control information described in each of the independent claims of the instant application is not managing control information to any extent. Applicants respectfully submit that the tentative control information described in each of the independent claims of the instant application is information used for forming managing control information.

Applicants respectfully submit that Okada and the other references do not disclose, teach, or even suggest, the tentative control information used for forming managing control information, as described in each of the independent claims of the instant application.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because the applied art of record, whether taken separately or in combination with each other does not teach or suggest each feature of independent claims 1, 7, and 12 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from independent claims 1, 7 and 12, and the reasons set forth above.

The additionally applied reference to Nozaki, with respect to claims 2, 3, 5, 8, 9, 11, 13, 14 and 16, does not cure the deficiencies discussed above with regard to Okada. Similarly, the additionally applied reference to Kikuchi, with regard to claim 6, does not cure the deficiencies discussed above with regard to Okada. In addition, the rejection of claim 6 under 35 U.S.C. § 103(a) is in question because it relies on only Nozaki and Kikuchi while claim 6 is dependent on claim 1, which is rejected with Okada. It follows that the rejection of claim 6 is possibly in error because it does not apply the art applied against the claim 6's independent claim 1.

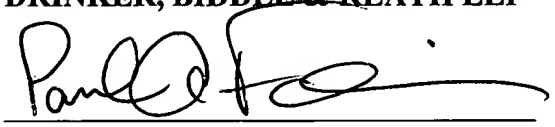
CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

Dated: July 25, 2006 By: 

Paul A. Fournier
Registration No. 41,023

Customer No. 055694
DRINKER, BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
Tel: (202) 842-8800
Fax: (202) 842-8465